

**REMARKS**

In the Office Action<sup>1</sup>, the Examiner:

rejected claims 1-42 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 6,463,421 to Junger (“*Junger*”); and

rejected claim 43 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,463,421 to *Junger* in view of U.S. Publication No. 2001/0032143 to Haseltine (“*Haseltine*”).

By this amendment, claims 1-43 remain pending. Claim 12 is amended.

**I. Rejection of claims 1-42 under 35 U.S.C. § 102(b)**

Applicant respectfully traverses the rejection of claims 1-42 under 35 U.S.C. § 102(b) as anticipated by *Junger*.

In order to properly establish that *Junger* anticipates Applicant’s claimed invention under 35 U.S.C. § 102(b), each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in a single reference. Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989) (emphasis added).

Independent claim 1 recites, among other things, “capturing the disposition decision for the product return in a first management system; communicating the captured disposition decision from the first management system to the second

management system; and triggering, in response to the captured disposition decision, at least one process in the second management system.” *Junger* does not teach or suggest at least either “capturing the disposition decision” or “a second management system” as recited by claim 1.

The Examiner asserts “fig. 3, item 324 and col. 8 lines 17-32 [of Junger] discuss [disposition] decision information.” Office Action of 2/26/2008 at page 2. This is not correct.

*Junger* states “control goes to function block 312 upon submission of a return authorization request . . . If the good scans fail re-validation, control proceeds to function block 316, which flags the batch header with an error indication, and notifies the return center operator of the failure. Otherwise, control proceeds to function block 318 for automated approval.” *Junger* col. 8 lines 5-6 and 13-17 (emphasis added). Further, *Junger* states “[f]unction block 320 checks to determine whether the automated approval process was successful. If not, an e-mail message may be sent to a manufacturer’s representative for the particular return center.” *Junger* col. 8 lines 18-21. However, such a disclosure does not constitute a disclosure or suggestion of “capturing the disposition decision,” as recited in claim 1.

*Junger* discloses “approval” of a “return authorization request,” as cited above. However, at the point *Junger* approves or declines the request, *Junger* is not “capturing the disposition decision for the product return” because *Junger* is referring to an authorization to return the product, not a “disposition decision” for the product. *Junger*

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<sup>1</sup> The Office Action contains a number of statement reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement of characterization in the Office Action.

cannot “capture the disposition decision” at the time of the “return authorization request” because *Junger* has not yet given approval for the product to be returned. The disposition decision for a product cannot be determined if the product is not approved for return. Therefore, “approval” of a “return authorization request” cannot constitute “capturing the disposition decision for the product return.” For at least this reason, the rejection to claim 1 should be withdrawn and claim 1 allowed.

Further, *Junger* does not disclose a “second management system” as recited by independent claim 1. The Examiner alleges *Junger* discloses a second management system by stating “fig. 3, item 324 and col. 8 lines 17-32 discusses communicating the captured disposition decision with a[n] indication flag associated with [the] product.” Office Action of 2/26/2008 at page 2-3. There is however, no disclosure or suggestion of the claimed “second management system” in the above identified portions of *Junger*, or otherwise in *Junger*. Since there is no disclosure of a “second management system,” the Office Action’s characterization of *Junger* is not correct.

*Junger* discloses “an e-mail message may be sent to a manufacturer’s representative for the particular return center. . . If manual review shows that the request was properly rejected, the batch is flagged with an indication that the request was rejected, and the return center is notified of the rejection.” *Junger* col. 8 lines 18-21, 24-27. However, this disclosure does not disclose or suggest the claimed “communicating the captured disposition decision from the first management system to a second management system.”

*Junger* discloses “a manufacturer’s representative,” “notification” to a return center, and that “the batch is flagged.” Even if, an indication flag could constitute the

claimed communication, which the Applicant does not concede, it is not “communicating the captured disposition decision from the first management system to a second management system” because neither a manufacturer’s representative nor, a return center receiving notification discloses or suggests “a second management system.” The manufacturer’s representative cannot constitute “a second management system” because a person is not a management system. A return center receiving notification cannot constitute a “second management system” because a return center is not a management system. Thus, *Junger* does not disclose every element of claim 1. Since *Junger* does not disclose either “capturing the disposition decision for the product return,” or “a second management system,” the rejection under 35 U.S.C. § 102(b) is improper.

For at least the above reasons, independent claim 1 is not anticipated by *Junger*. Claims 2-7 are allowable for at least the reason that they depend from allowable claim 1. Independent claims 8, 12, 18, 25, 29, and 34, although of a different scope, include recitations similar to those discussed above in relation to independent 1 and are not anticipated by *Junger* for reasons at least similar to those discussed with respect to claim 1. Claims 9-11, 13-17, 19-24, 26-28, 30-33, and 35-43 are allowable for at least the reason that they depend from one of allowable claims 8, 12, 18, 25, 29, and 34 respectively. Therefore, the Examiner should withdraw the rejection of claims 1-42, under 35 U.S.C. § 102(b).

**II. Rejection of claim 43 under 35 U.S.C. § 103(a)**

Applicant respectfully traverses the rejection of claim 43 under 35 U.S.C. § 103(a) as unpatentable over *Junger* in view of *Haseltine*. A *prima facie* case of obviousness has not been established.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. *See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007)*. “A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention.” *M.P.E.P. § 2145*. Furthermore, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” at the time the invention was made. *M.P.E.P. § 2143.01(III), internal citation omitted*. Moreover, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” *M.P.E.P. § 2141.02(I)*, internal citations omitted (emphasis in original).

“[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459 (1966).... The factual inquiries ... [include determining the scope and content of the prior art and] ... [a]scertaining the differences between the claimed invention and the prior art.” *M.P.E.P. § 2141(II)*. “Office personnel must explain why the difference(s)

between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” *M.P.E.P. § 2141(III)*.

Here, a *prima facie* case of obviousness has not been established because the Examiner has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Accordingly, the Examiner has failed to clearly articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art.

As noted above, *Junger* does not disclose “a second management module.” *Haseltine*, however, does not remedy the deficiencies of *Junger*. The Examiner alleges “*Haseltine* teaches a method and system providing out-sourced, merchandise return services, wherein the second management module determines, based on the effort code, an effort value to charge a customer account for the additional effort activity ([0011] discusses a restocking fee, which is construed as an effort value charge).” Office Action of 2/26/2008 at page 15.

*Haseltine* discloses “[n]ow a handful of merchants are covering all return shipping costs, and even allowing customers to return online purchases to their stores. But the majority of sites still have a lot of work to do on their return processes.” *Haseltine* paragraph [0011]. Such a disclosure, however, does not teach or suggest “a second management module” as recited by claim 34 as described above in reference to the *Junger* disclosure.

In view of the mischaracterization of the *Haseltine* reference above, the Examiner has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the invention of claim 34. Thus,

the Examiner has failed to clearly articulate a reason why claim 34 would have been obvious to one of ordinary skill in the art in view of the prior art. Accordingly, a *prima facie* case of obviousness has not been established with respect to claim 34.

Claim 43 depends from allowable claim 34 and therefore incorporates every element of claim 34. Since claim 34 is allowable, claim 43 is allowable for at least the same reasons as claim 34. Accordingly, a *prima facie* case of obviousness has not been established with respect to claim 43, and the rejection under 35 U.S.C. § 103(a) must be withdrawn.

### CONCLUSION

In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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